

REMARKS

Formalities

Claims 29-39 were pending in the application. Claims 29-35, 38 and 39 were allowed by the Examiner. Claim 37 has been canceled. Claim 36 has been amended. The amendments to the claims do not add or constitute new matter. Support for the amendments may be found throughout the specification and originally filed claims. More particularly, support for the amendment to claim 36 may be found, for example, at page 11, line 29 through page 13, line 14, of the specification.

The foregoing amendments are made solely to expedite prosecution of the instant application and are not intended to limit the scope of the invention. Further, the amendments to the claims are made without prejudice to the pending or now canceled claims or to any subject matter pursued in a related application. The Applicant reserves the right to prosecute any canceled subject matter at a later time or in a later filed divisional, continuation, or continuation-in-part application.

Upon entry of the amendment, claims 29-36 and 38-39 are pending in the instant application.

Rejection under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 36 and 37 under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Applicant respectfully traverses this rejection.

Specifically, the Examiner asserts that claims 36 and 37 are incomplete for omitting essential steps, such omission amounting to a gap between the steps. The Examiner alleges that this omitted step is the selection of the ES cells that have undergone homologous recombination. The Applicant disagrees that the omission of this step amounts to a gap between steps, and submits that the steps recited in the previous version of the recite each step regarded as the invention. The Examiner has further alleged that the phrase “wherein the pseudopregnant mouse gives birth” renders the claim indefinite because a pseudopregnant mouse cannot give birth. Applicants also traverse this aspect of the rejection. Although Applicants disagree with the Examiner’s conclusions and traverse the rejection, claim 36 has been amended to include the allegedly omitted step and recite that the “resultant mouse” and not a pseudopregnant mouse

gives birth. Claim 37 has been canceled. Therefore, the rejection is no longer relevant, and Applicant respectfully requests withdrawal of the rejection. .

Applicant submits that the pending claims are definite and particularly point out and distinctly claim the subject matter regarded as the invention in accordance with 35 U.S.C. § 112, second paragraph.

Claim Objections

Claim 37 has been objected to by the Examiner under 37 C.F.R. § 1.75 as being a substantial duplicate of claim 33. The Applicant disagrees. However, Applicant has overcome the objection by the cancellation of claim 37.

It is believed that the claims are currently in condition for allowance, and notice to that effect is respectfully requested. The Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-1271 under Order No. R-716.

Respectfully submitted,

Date: April 13, 2004

Kelly L. Quast
Kelly L. Quast, Reg. No. 52,141

Deltagen, Inc.
1031 Bing Street
San Carlos, CA 94070
(650) 569-5100